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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,716	09/09/2003	Holger Hoffmann	1454.1483	8738
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STAAS & HALSEY LLP			DICKERSON, CHAD S	
SUITE 700			ART UNIT	
1201 NEW YORK AVENUE, N.W.			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/657,716	HOFFMANN, HOLGER	
	Examiner	Art Unit	
	Chad Dickerson	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09 September 2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1, 3, 8 and 9 objected to because of the following informalities:
 - Re claim 1: on line 4, the phrase “the first fax machine” should be changed to -- a first fax machine --.
 - On line 6, the phrase “the second fax machine” is suggested to be changed to -- a second fax machine --.
 - On line 14, the phrase “the sending fax machine” is suggested to be changed to -- a sending fax machine --.
 - Re claim 3: the phrase “the type of fax machine” is suggested to be changed to -- a type of fax machine --.
 - Re claim 8: the phrase “the CAPI standard” is suggested to be changed to -- a CAPI standard --.
 - Re claim 9: the phrase “the type of fax machine” is suggested to be changed to -- a type of fax machine --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1: the phrase "setting up a transmission-controlling connection between the first fax machine and the first data gateway" renders the claim indefinite. In the specification, there is a set up of a connection that controls the transmission of data between the first network unit and the data gateway and there also is a connection that controls the transmission of data between the fax protocol and the data gateway that acts like a fax machine. However, when it comes to an aspect of the invention mentioned in paragraph [0055] it states a transmission-controlling connection between a second fax protocol unit and a second data gateway. Is this statement in paragraph [0055] reflective of the claim language mentioned above that renders the claim indefinite? These two phrases are not the same, but this is what applicant claims as the inventive feature over the prior art. Both claim limitations mentioning the first and second fax machines and data gateways will be given their broadest reasonable interpretation.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Tajiri '420 (US Pat No 69758420).

Re claim 1: A method for setting up a fax connection between a calling fax machine controlled by a first communication facility and a called fax machine controlled by a second communication facility over a packet-oriented network connecting the communication facilities, comprising:

terminating sent data of the first fax machine at a first data gateway belonging to the first communication facility (i.e. when resources need to be released, the fax machine sends messages or data through the network unit to the data gateway. Step t0 is an example of the first fax machine using the network unit (NU1) to send request data to request the provisioning of resources of the first data gateway for data connection to the other fax machine in the system. This request is sent to the first data gateway, where it is terminated, which belongs to the first communication facility shown in figure 3; see figs. 2 and 3; paragraphs [0015]-[0024] in applicant's specification);

terminating sent data of the second fax machine at a second data gateway belonging to the second communication facility (i.e. the second fax machine sends data to the second data gateway requesting provisioning of resources for the second data

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gateway for the data connection to be set up for the first fax machine. The second fax machine sends data to the second data gateway that is terminated at the second data gateway, which belongs to the second communication facility; see figs. 2 and 3; paragraphs [0025]-[0027] of applicant's specification);

setting up a useful data connection between the first and second data gateways (i.e. in the background of the invention, at set t5, the connection setup of a useful data connection takes place between the first data gateway (DG1) of the first fax protocol and the second data gateway (DG2) of the second fax protocol; see figs. 2 and 3; paragraphs [0028] and [0029] of applicant's specification);

setting up a transmission-controlling connection between the first fax machine and the first data gateway (i.e. the first data gateway acts as a fax machine communicating to the fax machine important information it receives. Once the first data gateway sets up the transmission connection with control messages, analogous to transmission-controlling connection, this sets up the first fax machine for transmission that will occur later on in the process. Illustrated in steps t14-16, the set up of the connection of the fax machine with the respective data gateway and the fax protocol takes place before the transmission of the image data occurs. Step t14, indicates the successful initialization of the sender side arrangements for initiating the data connection to the first data gateway, which is analogous to setting up the connection that controls the transmission of data between the first fax machine to the first data gateway. Also, with the connection setup occurring in t5 that setup a data connection between the fax machines and their respective gateways, without this connection being

established, the transmission of data would not occur. Therefore, this also can be considered as process that performs a transmission-controlled connection; see figs. 2 and 3; paragraphs [0041]-[0045]);

setting up a transmission-controlling connection between the second fax machine and the second data gateway (i.e. the second data gateway acts as a fax machine communicating to the fax machine important information it receives. Once the second data gateway sets up the transmission connection with control messages, analogous to transmission-controlling connection, this sets up the second fax machine for transmission that will occur later on in the process. Shown in figure 2B, steps t19-t22, illustrates the set up of the connection of the second fax machine with the respective data gateway. The second fax protocol establishes a connection with the second data gateway so that data can be transmitted to the second data gateway from the second fax protocol. Also, with the connection setup occurring in t5 that setup a data connection between the fax machines and their respective gateways, without this connection being established, the transmission of data would not occur. Therefore, this also can be considered as process that performs a transmission-controlled connection; see figs. 2 and 3; paragraphs [0045]-[0052]); and

transmitting identification information of the sending fax machine from the first data gateway to the second data gateway (i.e. in step t17, the system of the related art transmits identification information to the second data gateway from the first data gateway of the sending or transmitting fax machine. This is clearly shown in figure 2B; see figs. 2 and 3; paragraphs [0045]-[0052])).

However, the admitted prior art fails to teach after setting up the transmission-controlling connection between the second fax machine and the second gateway, transmitting identification information of the sending fax machine from the first data gateway to the second data gateway.

However, this is well known in the art as evidenced by Tajiri '420. Tajiri '420 discloses after setting up the transmission-controlling connection between the second fax machine and the second gateway, transmitting identification information of the sending fax machine from the first data gateway to the second data gateway (i.e. when viewing figure 5A, it is clear which facsimile is the transmitter and receiver. Both have established communication with their respective image gateways, or internet faxes (10 and 110), and the receiving facsimile is sending packets over to the transmitting fax machine. The transmitting fax machine now sends TSI or Transmitting Station Identification, which is similar to the TSI mentioned in applicant's specification. This performs the feature of having the TSI sent to a second fax machine from a first fax machine with the first fax machine being the transmitting fax machine; see figs. 5a and 5b; see col. 6, lines 38-67 and col. 7, lines 1-35).

Therefore, in view of Tajiri '420, it would have been obvious to one of ordinary skill at the time the invention was made to have after setting up the transmission-controlling connection between the second fax machine and the second gateway, transmitting identification information of the sending fax machine from the first data gateway to the second data gateway in order to send the TSI in response to the

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commands sent to the transmitting fax machine from the receiving fax machine (as stated in Tajiri '420 col. 6, lines 35-67).

Re claim 3: The teachings of admitted prior art in view of Tajiri '420 are disclosed above. The admitted prior art discloses the method according to claim 1, wherein the identification information identifies the type of fax machine (i.e. as stated in paragraph [0045] of the background of the invention, the TSI can be details of the type of fax; see paragraph [0045] of the background of the invention).

Re claim 4: The teachings of admitted prior art in view of Tajiri '420 are disclosed above. The admitted prior art discloses the method according to claim 1, wherein the identification information contains information about a directory number identifying the fax machine (i.e. as stated in paragraph [0045] of the background of the invention, the TSI can comprise of a directory number identifying the first fax machine or any other machine; see paragraph [0045] of the background of the invention).

Re claim 5: The teachings of admitted prior art in view of Tajiri '420 are disclosed above. The admitted prior art discloses the method according to claim 1, wherein at least one of the first and second data gateways employs a fax protocol unit for converting connection-controlling useful data (i.e. at step t7, the fax protocol is used in the first data gateway in order to receive a request for opening a useful data channel for the waiting remote copy data transmission. The first fax protocol translates or converts this

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incoming information and opens up a useful data channel. This is an example of converting the connection-controlling useful data since it opens up a useful data connection based on the control message sent to the fax protocol; see figs. 2 and 3; paragraphs [0030]-[0035]).

Re claim 6: The teachings of admitted prior art in view of Tajiri '420 are disclosed above. The admitted prior art discloses the method according to claim 1, wherein both the first and second data gateways employ a fax protocol unit for converting connection-controlling useful data (i.e. at step t7, the fax protocol is used in the first data gateway in order to receive a request for opening a useful data channel for the waiting remote copy data transmission. The first fax protocol translates or converts this incoming information and opens up a useful data channel. This is an example of converting the connection-controlling useful data since it opens up a useful data connection based on the control message sent to the fax protocol. Also, in step t19, a request is sent from the second data gateway to the second fax protocol requesting for the fax protocol to open up a useful data channel or connection for the waiting remote copy data transmission. The second fax protocol converts the useful data that controls the setting up of a connection in the system; see figs. 2 and 3; paragraphs [0030]-[0052]).

Re claim 7: The teachings of admitted prior art in view of Tajiri '420 are disclosed above. The admitted prior art discloses the method according to claim 6, wherein control messages are exchanged between the fax protocol units and the data gateways, and

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the control messages are received and sent by an intermediately connected application interface (i.e. as stated in the background of the invention in paragraph [0033], control messages are sent between the fax protocols and the data gateways, which implies that one has to be a transmitter and one a receiver in the messaging process. These messages are sent and received via an intermediately connected CAPI protocol unit, which is also considered application interface; see paragraph [0033]).

Re claim 8: The teachings of admitted prior art in view of Tajiri '420 are disclosed above.

The admitted prior art discloses the method according to claim 7, wherein the application interface is embodied according to the CAPI standard (i.e. the application interface used in sending and receiving the messages in the system uses the known interface CAPI, which is a software or communication interface that makes the communication protocols available for the useful data channel; see paragraph [0033]).

6. Claims 2, 9-13 rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, modified by Tajiri '420 (US Pat No 6975420), and further in view of Johnson '585 (US Pat No 6480585).

Re claim 2: The teachings of the admitted prior art in view of Tajiri '420 are disclosed above.

The admitted prior art discloses the method according to claim 1, wherein the transmission-controlling connection between the second fax machine and second data

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gateway is set up with the transmission-controlling connection between the first fax machine and the first data gateway (i.e. shown in figure 2A and 2B, the transmission-controlling connection between the first fax machine and data gateway is set up with the transmission-controlling connection between the second fax machine and data gateway. With the data gateways acting as fax machine, since they communicate information to the fax machine at the level of the protocols, the above features are performed; see applicant's specification paragraphs [0042]-[0052]).

However, the admitted prior art fails to teach set up synchronously.

However, this is well known in the art as evidenced by Johnson '585. Johnson '585 discloses set up synchronously (i.e. Johnson '585 discloses having a first gateway and a first facsimile being synchronized and the second facsimile and gateway are also synchronized at the same rate. With these two facsimiles having the same data transfer rate being synchronized, they both can be synchronized in communicating data to one another. With the synchronizing feature of Johnson '585 and the transmission controlling connection between both fax machines and their respective gateways in the admitted prior art combined together, the above feature is performed; see col. 9, lines 7-31).

Therefore, in view of Johnson '585, it would have been obvious to one of ordinary skill at the time the invention was made to have the system set up synchronously in order to perform synchronized functions (as stated in Johnson '585 col. 9 lines 7-31).

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Re claim 9: The teachings of the admitted prior art, modified by Tajiri '420, and further in view of Johnson '585 is disclosed above.

The admitted prior art discloses the method according to claim 2, wherein the identification information identifies the type of fax machine (i.e. as stated in paragraph [0045] of the background of the invention, the TSI can be details of the type of fax; see paragraph [0045] of the background of the invention).

Re claim 10: The teachings of the admitted prior art, modified by Tajiri '420, and further in view of Johnson '585 is disclosed above.

The admitted prior art discloses the method according to claim 9, wherein the identification information contains information about a directory number identifying the fax machine (i.e. as stated in paragraph [0045] of the background of the invention, the TSI can comprise of a directory number identifying the first fax machine or any other machine; see paragraph [0045] of the background of the invention).

Re claim 11: The teachings of the admitted prior art, modified by Tajiri '420, and further in view of Johnson '585 is disclosed above.

The admitted prior art discloses the method according to claim 10, wherein the first and second data gateways employ a fax protocol unit for converting connection-controlling useful data (i.e. at step t7, the fax protocol is used in the first data gateway in order to receive a request for opening a useful data channel for the waiting remote copy data transmission. The first fax protocol translates or converts this incoming information and

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opens up a useful data channel. This is an example of converting the connection-controlling useful data since it opens up a useful data connection based on the control message sent to the fax protocol; see figs. 2 and 3; paragraphs [0030]-[0035]).

Re claim 12: The teachings of the admitted prior art, modified by Tajiri '420, and further in view of Johnson '585 is disclosed above.

The admitted prior art discloses the method according to claim 11, wherein both the first and second data gateways employ a fax protocol unit for converting connection-controlling useful data (i.e. at step t7, the fax protocol is used in the first data gateway in order to receive a request for opening a useful data channel for the waiting remote copy data transmission. The first fax protocol translates or converts this incoming information and opens up a useful data channel. This is an example of converting the connection-controlling useful data since it opens up a useful data connection based on the control message sent to the fax protocol. Also, in step t19, a request is sent from the second data gateway to the second fax protocol requesting for the fax protocol to open up a useful data channel or connection for the waiting remote copy data transmission. The second fax protocol converts the useful data that controls the setting up of a connection in the system; see figs. 2 and 3; paragraphs [0030]-[0052]).

Re claim 13: The teachings of the admitted prior art, modified by Tajiri '420, and further in view of Johnson '585 is disclosed above.

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The admitted prior art discloses the method according to claim 12, wherein control messages are exchanged between the fax protocol units and the data gateways, and the control messages are received and sent by an intermediately connected application interface (i.e. as stated in the background of the invention in paragraph [0033], control messages are sent between the fax protocols and the data gateways, which implies that one has to be a transmitter and one a receiver in the messaging process. These messages are sent and received via an intermediately connected CAPI protocol unit, which is also considered application interface; see paragraph [0033]).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
8. Endo '038 (US Pat No 6381038) discloses a system that has the facsimiles establish communication with their respective gateways and the identification information of a facsimile is performed after both facsimile devices are connected to their respective gateways.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Dickerson whose telephone number is (571)-270-

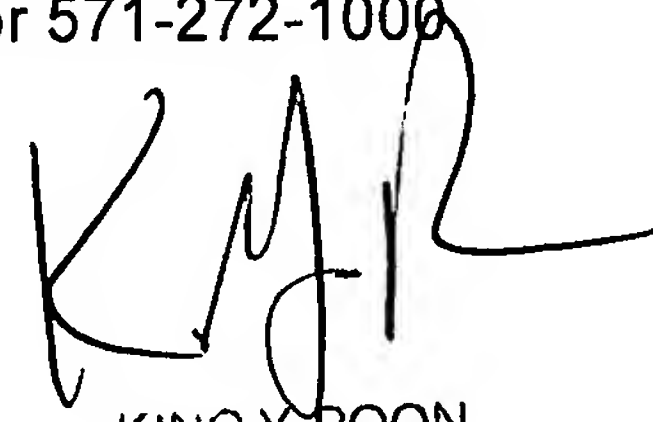
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1351. The examiner can normally be reached on Mon. thru Thur. 9:00-6:30 Fri. 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on (571)- 272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CD/ 
Chad Dickerson
August 17, 2007


KING Y. POON
SUPERVISORY PATENT EXAMINER